

Application No.: 09/552,252

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Docket No.: 416272002220

**REMARKS/ARGUMENTS**

In an Office Action dated May 10, 2004, claims 1-8 and 10-42 were rejected. By this amendment, claims 1, 15, 25, 32, 34, and 35 have been amended. Claims 9, 14, and 33 are canceled. Claims 1-8, 10-13, 15-32 and 34-42 remain pending. Applicants request reconsideration of the pending claims in view of the present amendment and following remarks.

Telephonic Interview

Applicants thank the Examiners Georgia Helmer and Phuong Bui for the helpful telephone interview on Thursday July 29, 2004. This amendment is in response to those discussions.

Claim Rejections – 35 USC § 112, second paragraph

The Examiner has rejected claims 25-42 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. The Examiner has asserted that the limitation “green regenerative tissue” lacks a working definition.

Applicants respectfully disagree with the Examiner’s grounds for rejection and the above statements. However, in order to facilitate prosecution in this case applicants have amended the pending claims, without prejudice or disclaimer, to add the recitation in the claims “green, shiny, nodular, compact.” This amendment does not add new matter as this description of green regenerative tissue is found throughout the specification. By way of example, on page 41, lines 4 through 25, the specification describes how to produce and maintain green regenerative tissue which is clearly described as green, shiny, nodular and compact.

As amended, claim 25 clearly covers production of “green, shiny, nodular, compact tissue as compared to monocot plant callus tissue.” Claim 32 similarly includes “selecting green, shiny, nodular, compact structures as compared to the surrounding tissue.” Finally, claim 35 covers production of “green, shiny, nodular, compact tissue as compared to monocot plant callus tissue.” The other claims have been amended to ensure that consistent claim language is used throughout. Applicants respectfully request that the Examiner withdraw the definiteness rejection.

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Claim Rejections – 35 USC § 102(b)

The Examiner has rejected claims 1-6 and 10-16 as being anticipated by Wan, Y. *et al.* (Plant Physiology 104:37-48 (1994)). The Examiner has asserted that the limitation “for a time sufficient to promote proliferation and formation of a transformed structure competent to regenerate from said transformed plant cell” provided insufficient guidance as to the time period for the culturing under dim light, so the dim light limitation may be read out of the claim and that the bounds of “approximately 10-30  $\mu$ E” is not defined.

Applicants respectfully disagree with the Examiner’s grounds for rejection and the above statements. However, in order to facilitate prosecution in this case applicants have amended the pending claims, without prejudice or disclaimer, to replace the recitation of the time for exposure to dim light with “at least five days.” This amendment does not introduce new matter. Support may be found throughout the specification. By way of example, the specification on page 41, line 5, indicates that it takes 5-20 days for the green regenerative tissue to form; thus, one of skill in the art would understand that the dim light needs to be applied for at least 5 days. The applicants maintain that the boundaries of “approximately 10-30  $\mu$ E” is clear and would not include approximately 45-55  $\mu$ E as taught by Wan *et al.*

In order to anticipate, a reference must teach all elements of a claim. In this case, the claims include a limitation that the plant tissue must be cultured under dim light of approximately 10 to 30  $\mu$ E for at least five days. Wan *et al.* fail to teach culturing transformed plant cells under dim light “approximately 10 to 30  $\mu$ E” “for at least five days”. Thus Wan *et al.* does not anticipate the claimed invention. Applicants respectfully request that the Examiner withdraw the rejection.

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 1-8 and 10-42 as being unpatentable over Wan, Y. *et al.* (Plant Physiology 104:37-48 (1994)) in further view of Bhojwani *et al.*, in Plant Tissue Culture, Elsevier, Amsterdam, 1983, pages 25-41. The Examiner has asserted that notwithstanding that Wan *et al.* do not teach the commercially available cultivars recited in claims 17-24, it would be well

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within the means of one of ordinary skill in the art to transform and regenerate such commercially valuable cultivars.

Applicants respectfully disagree with the Examiner's grounds for rejection and the above statements. In order to render a claimed invention obvious, the references must teach or suggest all elements of a claim. As discussed above, the claims include a limitation that the plant tissue must be cultured under dim light of approximately 10 to 30  $\mu$ E for at least five days. Neither Wan *et al.* nor Bhojwani *et al.* teach or suggest any dim light exposure of approximately 10 to 30  $\mu$ E or the time for such dim light exposure, so they fail to teach or suggest all elements of the currently claimed invention. Applicants respectfully request that the Examiner withdraw the rejection because Wan *et al.* in light of Bhojwani *et al.* fail to render the claimed invention obvious.

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**Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 416272002220. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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